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**37 CFR 1.7(c) FILING RECEIPT AND  
TRANSMITTAL LETTER WITH  
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

Neifeld Docket No.: PIP-69B-KATZ  
US/PCT Application/Patent No.: 09/828,122  
Priority Data:  
Inventor: Gary M. KATZ  
Title: Paired Promotion Architecture

Client Ref:  
US/PCT File/Issue Date: 4/9/2001  
USPTO Confirmation No.: 5972

**THE FOLLOWING HAS BEEN RECEIVED IN THE U.S. PATENT OFFICE ON  
THE DATE STAMPED HEREON:**

37 CFR 1.7(c) Filing Receipt and Transmittal Letter with Authorization to Charge Deposit Account (in duplicate)  
Check for \$130.00  
37 CFR 1.181 Petition to Withdraw the Restriction Requirement (7 pages)

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106. A duplicate copy of this sheet is enclosed.

7/18/06  
DATE

Respectfully Submitted,

Richard A. Neifeld  
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	PcLaw Matter	Lawyer	Amount	Explanation	Date Entered	Initials
Fees:	PIP-69B-KATZ	BTM	300	PIP-69B-KATZ firm charge for paying fee for petition.	7/17/2006	BTM
Fees:						
Disbursements:	PcLaw Matter	G/L Account	Amount	Explanation	Date Entered	Initials
	PIP-69B-KATZ	5010	130	PIP-69B-KATZ gov. fee for petition.	7/17/2006	BTM

Printed: September 30, 2005 (1:31pm)

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NEIFELD DOCKET NO: PP-69B-KATZ

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: Gary M. KATZ

CONF. NO: 5972

GROUP ART UNIT: 3622

SERIAL NO: 09/828,122

FILED: April 9, 2001

EXAMINER: RETTA

FOR: Paired Promotion Architecture

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22213-1450

37 CFR 1.181 PETITION TO WITHDRAW THE RESTRICTION REQUIREMENT

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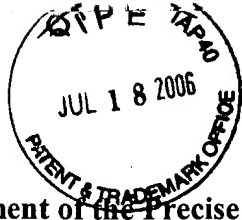
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**I. Statement of the Precise Relief Requested**

The applicant request that the Director withdraw the restriction requirement imposed in the office action mailed March 27, 2006.

**II. Material Facts in Support of the Petition**

1. On April 9, 2001, the applicant filed application no: 09/828,122.
2. On June 3, 2003, the applicant filed an amendment adding claims 28 and 29.
3. On June 28, 2004, Examiner Retta mailed a non-final first office action rejecting claims 1-29.
4. In response to the non-final office action mailed June 28, 2004, on September 28, 2004, the applicant timely filed an amendment adding claims 30-34.
5. Further to the amendment filed September 28, 2004 and further to the non-final office action mailed June 28, 2004, on September 30, 2004, the applicant timely filed an amendment adding claims 35-58.
6. On December 13, Examiner Retta mailed a final office action rejecting claims 1-58.
7. In response to the final office action mailed December 13, 2004, on May 10, 2005, the applicant timely filed an appeal brief.
8. On July 29, 2005, Examiner Retta reopened prosecution and mailed a non-final first office action rejecting claims 1-58.
9. In response to the non-final office action mailed July 29, 2005, on December 27, 2005, the applicant timely filed an amendment adding claims 59-64.
10. In response to the non-final office action mailed July 29, 2005, on December 28, 2005, the applicant timely filed an appeal brief.
11. On March 27, 2006, Examiner Retta mailed final office action rejecting claims 1-58 and withdrawing claims 59-64. This office action also included an election of species requirement. The cover page of the office action dated March 27, 2006 indicates that claims 1-64 are pending in the application. Claims 1-64 are subject to restriction. The body of the office action states that:

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-58, drawn to pairing a first low relevance promotion with a second more relevant promotion, classified in class 705, subclass 14.
- II. Claims 59-64, drawn to determining a first product, from a first product category or from a first product in a product category, that has not been purchased before by a consumer and determining a second product from a second category that has been purchased before and printing on a single sheet of paper the first promotion to purchase a product from a product item in the first category and a second promotion to purchase a product item from the second category classified in class 705, subclass 14.

Newly submitted claims 59-64 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claim recites determining a promotion for a product which has never been purchased and pairing it with a promotion for a product that has been purchased before, by the same consumer.

Examiner considers that since applicant independently claim the invention of this group, it is prima facie showing that the inventions are intended to be independently and distinct and are shown to be separately usable.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 59-64 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP Section 821.03. [Office action mailed 3/27/2006 page 2 line 16 through page 3 line 15.]

- 12. In response to the election of species requirement mailed March 27, 2006, on April 4, 2006, the applicant timely filed a response to the election of species requirement provisionally electing claims 1-58 with traverse.
- 13. In response to final office action mailed March 27, 2006, on June 27, 2006, the applicant timely filed an appeal brief.

### **III. Reasons Why the Relief Requested Should be Granted**

#### **A. Summary**

The restriction requirement should be withdrawn because (1) the examiner has not shown it to be proper and (2) it is in fact improper.

The examiner must show a serious burden in examining the application claims prior to

imposing a restriction requirement. However, the examiner has not established any burden in examining Groups I and II, and therefore has not established “the reasons for insisting upon restriction” as required by MPEP 808.

**1. No Showing that the Inventions as Claimed are Either Independent or Distinct**

The examiner has presented no reason why the inventions as claimed are either independent or distinct. The examiner’s sole rationale is presented the office action mailed March 27, 2006 page 3 lines 6-8, which states that:

[Claims 59-64 recite] determining a promotion for a product which has never been purchased and pairing it with a promotion for a product that has been purchased before, by the same consumer.

This statement merely summarizes certain limitations in Group II. However, it has no relevance to the requirement for restriction without a discussion as to why Group I and Group II are independent and distinct.

**2. The Examiner Makes Unsupported Conclusions**

In the office action mailed March 27, 2006 page 3 lines 9-11 with interpolation provided, the examiner states that:

Examiner considers that since applicant independently claim [sic] the invention of this group, it is prima facie showing that the inventions are intended to be independently [sic] and distinct and are shown to be separately usable.

The examiner’s conclusion – that added claims are prima facie independent, distinct, and separately usable – has no factual basis.

**3. No Basis for a Holding of Independence or Distinctness**

The examiner has provided no reasons for a holding of independence or distinctness. The examiner has only presented a mere statement of conclusion, an assertion that MPEP 816 expressly describes as “inadequate.” Furthermore, the examiner has not presented a tenable reason for insisting upon restriction as specified in MPEP 816. Therefore, the requirement for restriction is improper and should be withdrawn.

**4. No Showing the Two Groups have Obtained a Separate Status in the Art or that Examining the Two Groups Imposes a Serious Burden**

The examiner indicated that the two groups are classified in the same class and subclass and did not assert that the two groups have obtained a separate status in the art. The examiner has not shown that examining this application imposes a serious examination burden. Therefore, the applicant assert that the requirement for restriction is improper and should be withdrawn.

**5. Conclusion**

In summary, the restriction requirement is improper because the examiner has shown no basis for insisting upon restriction, for holding that the groups are independent or distinct. Moreover, the restriction requirement unfairly biases the applicant as to wasted prosecution costs and patent term in this application. Therefore, the restriction is improper and should be withdrawn.

**B. Comparison of MPEP Requirements to the Examiner's Basis for Restriction**

**1. MPEP 808**

MPEP 808 states:

**808 Reasons for Insisting Upon Restriction**

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections.

The examiner has not presented any reason why the inventions as claimed are either independent or distinct. The examiner has only presented the following statement:

[Claims 59-64 recite] determining a promotion for a product which has never been purchased and pairing it with a promotion for a product that has been purchased before, by the same consumer. [Office action mailed March 27, 2006 page 3 lines 6-8.]

The examiner's statement summarizes certain limitations in Group II. However, it has no relevance to this requirement for restriction without a discussion as to why Group I and Group II are independent and distinct.

Moreover, in the office action mailed March 27, 2006 page 3 lines 9-11 with interpolation provided, the examiner states that:

Examiner considers that since applicant independently claim [sic] the invention of this group, it is prima facie showing that the inventions are intended to be independently and distinct and are shown to be separately usable.

This conclusion by the examiner has no basis in fact. For the reasons presented above, the examiner has not presented a tenable reason for insisting upon restriction as specified in MPEP 808. Therefore, the requirement for restriction is improper and should be withdrawn.

## **2. MPEP 816**

MPEP 816 states, with emphasis supplied:

### **816 Give Reasons for Holding of Independence or Distinctness**

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.



For example, relative to combination and a sub-combination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not rely on the subcombination as its essential distinguishing part.

Each other relationship of claimed invention should be similarly treated and the reasons for the conclusions of distinctness of invention as claimed set forth.

The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to a process, or to subcombination, or to product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass. See MPEP § 809.

The examiner has provided no reasons for a holding of independence or distinctness. The examiner has only presented a mere statement of conclusion, an assertion that MPEP 816 expressly describes as “inadequate.” Furthermore, the examiner has not presented a tenable reason for insisting upon restriction as specified in MPEP 816. Therefore, the requirement for restriction is improper and should be withdrawn.

### **3. MPEP 803**

MPEP 803 states the burden on the examiner for a search and examination of an entire application:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

The examiner indicated that the two groups are classified in the same class and subclass

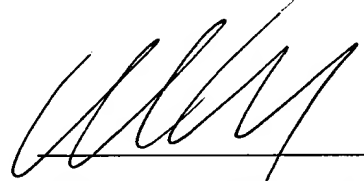
and did not assert that the two groups have obtained a separate status in the art. The examiner has not shown that examining this application imposes a serious examination burden. Therefore, the applicant assert that the requirement for restriction is improper and should be withdrawn.

**C. The Serious Burden Placed Upon the Applicant by the Requirement**

The applicants request that the examiner keep in mind the serious (and often unnecessary) financial burden placed upon *the applicants* in having to split prosecution between division applications in response to a requirement for restriction. Accordingly, the applicants request that the examiner withdraw the requirement for restriction.

Respectfully Submitted,

7/18/06  
Date

  
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Attorney of Record

BTM

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